

Application No. 10/606,786
Response to Office Action dated July 13, 2007

REMARKS

Claim 1 has been amended by requiring the composition to be transparent. Support for this amendment exists throughout the present specification, particularly pages 36-37.

Claims 1-46 are currently pending, although claims 44-46 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants respectfully request rejoinder of claims 44-46, which depend from claim 1, pursuant to MPEP § 821.04.

The Office Action rejected claims 1-43 under 35 U.S.C. § 103 as obvious over U.S. patent 5,556,615 (“Janchitraponvej”) in view of U.S. patent 4,390,522 (“Jacquet”), U.S. patent 6,214,326 (“Dupuis”) and U.S. patent 6,224,888 (“Vatter”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The claimed invention relates to transparent compositions containing at least one silicone with quaternary ammonium groups and at least one liquid fatty alcohol. As explained in the Background section of the present application, this unique combination of elements provides, among other things, transparent compositions with good hair conditioning properties despite the fact that such compositions contain liquid fatty alcohol. Such unique compositions are neither taught nor suggested by the prior art. That is, the art upon which the Office Action has relied neither teaches nor suggests the claimed invention, nor would such art lead one skilled in the art to the claimed invention with a reasonable expectation of success of producing a transparent composition.

As the Office Action has recognized (at page 8), Janchitraponvej does not teach or suggest adding a liquid fatty alcohol to his compositions. This is a significant omission, particularly in view of the fact that Janchitraponvej was seeking to produce “clear” compositions. (See, for example, col. 1, line 12). As explained at page 2, lines 4-6 of the

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present specification, conventional compositions containing liquid fatty alcohols were not transparent. Thus, the fact that Janchitraponvej was seeking to produce “clear” compositions explains why Janchitraponvej did not include liquid fatty alcohols as possible ingredients for inclusion into his compositions: adding liquid fatty alcohols to his compositions would have resulted in non-transparent compositions and, thus, would have been contrary to his purposes. Under such circumstances, no motivation could have existed to add liquid fatty alcohol to Janchitraponvej’s compositions. See MPEP § 2143.01.

In the Advisory Action dated November 19, 2007, the Office asserted that Applicants’ argument (asserted to be that one skilled in the art would not have been motivated to add a fatty alcohol to Janchitraponvej’s compositions because the result would have been a non-transparent composition) is without merit. To support this assertion, the Office used Applicants’ invention -- obtaining a transparent composition by combining the required ingredients -- as evidence. The Office’s arguments and assertions are improper for at least two reasons.

First, the Office misstates Applicants’ argument. Applicants’ argument is that no motivation would have existed to add a liquid fatty alcohol to Janchitraponvej’s compositions with the expectation that a transparent composition would result based upon the teachings of the applied art. Applicants do not argue that the claimed combination would not result in a transparent composition --- in fact, this is Applicants’ invention.

Second, the Office improperly relies upon Applicants’ invention to support the rejection. This constitutes nothing more than impermissible hindsight, using the present application as a guide, to combine the required elements together in such a way to yield the

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claimed transparent compositions. In other words, without Applicants' invention, the rejection could not be supported. Such a rejection is improper and should be withdrawn.

Jacquet cannot compensate for Janchitraponvej's deficiencies. That is, Jacquet would not motivate one skilled in the art to add liquid fatty alcohols to Janchitraponvej's "clear" compositions. Jacquet's disclosure of alcohols relates to producing "creams." (See, col. 6, line 67 et seq.). Because "creams" are recognized by those skilled in the art as being opaque, not clear, Jacquet teaches adding alcohols to produce opaque compositions, not clear compositions. Thus, no motivation would have existed to add Jacquet's alcohols (used to produce non-clear creams) to Janchitraponvej's clear compositions. Again, such an addition would have been contrary to Janchitraponvej's purposes.

Applicants respectfully submit that for at least this reason no *prima facie* case of obviousness has been set forth.

Furthermore, even assuming a *prima facie* case of obviousness has been set forth -- which is not the case -- sufficient evidence of unexpected/surprising results exists to rebut any such hypothetical case of obviousness. More specifically, the previously submitted Rule 132 declaration demonstrates the unexpected/surprising results associated with the claimed compositions.

The Office Action questioned the statistical significance of the data in the Rule 132 declaration, and asserted that the difference set forth in the declaration between the properties of the invention composition and the comparative compositions was merely one of degree, not kind. However, this assertion ignores the evidence of record set forth in the declaration. Specifically, the declaration indicates that the demonstrated differences are significant, and demonstrate that the invention compositions have unexpectedly and significantly better

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flexibility, smoothness and turbidity properties than comparative compositions according to standard testing methods. That is, the invention compositions were determined to be significantly better than comparative compositions using standard testing. Such evidence, by itself, is sufficient to demonstrate the unexpected benefits associated with the claimed compositions.

The unique combination of elements required by the present invention results in compositions having improved sensory and transparency characteristics. Compositions which do not contain either the required silicone with quaternary ammonium groups or the required liquid fatty alcohol do not possess such improved transparency and sensory characteristics. Clearly, the improved compositions of the present invention are neither taught nor suggested by the cited art.

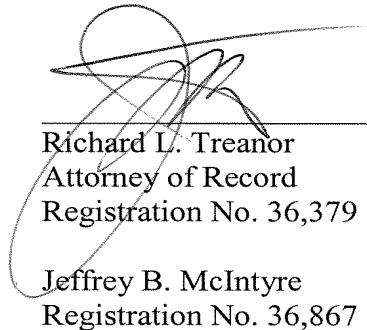
For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

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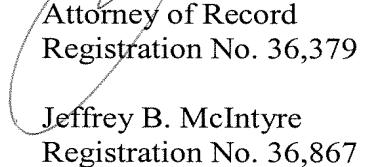
Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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